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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,374	10/17/2001	Wilhelmus Theodorus Antonius Maria De Laat	246152012710	8056

25225 7590 07/15/2003  
MORRISON & FOERSTER LLP  
3811 VALLEY CENTRE DRIVE  
SUITE 500  
SAN DIEGO, CA 92130-2332

EXAMINER

WINSTON, RANDALL O

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 07/15/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/982,474**

Applicant(s)  
**De Laat et al.**

Examiner  
**Randall Winston**

Art Unit  
**1654**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 15, 16, 19, 20, and 36-64 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-8, 15, 16, 19, 20, and 36-64 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, 15-16, 19-20, 36-37 and 52-63, drawn to a process for the production of Beta-Lactam, comprising the steps of fermenting on a volume scale of at least 10 m<sup>3</sup>, a microbial strain that produces a beta-lactam in a fermentation medium which contains only chemically defined components as carbon and nitrogen sources and contains no complex raw materials, classified in class 435, subclass 43, for example.

II. Claim 38, drawn to a process for the production of Beta-Lactam, comprising the steps of fermenting on a volume scale of at least 10 m<sup>3</sup>, a microbial strain (i.e. microbial strain is a mutated or recombinant Beta-Lactam producing strain) that produces a beta-lactam in a fermentation medium which contains only chemically defined components as carbon and nitrogen sources and contains no complex raw materials, classified in class 435, subclass 254.11, for example.

III. Claims 39-51, drawn to a to a process for the production of Beta-Lactam, comprising the steps of fermenting on a volume scale of at least 10 m<sup>3</sup>, a microbial strain (i.e. microbial strain is a mutated or recombinant Beta-Lactam producing strain) that produces a beta-lactam in a fermentation medium which contains chemically defined components and a complex carbon and/or nitrogen sources, classified in class 435, subclass 254.5, for example.

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IV. Claim 64, drawn to a process for the production of Beta-Lactam, comprising the steps of fermenting on a volume scale of at least 10 m<sup>3</sup>, a microbial strain that produces a beta-lactam in a fermentation medium which contains chemically defined components and a complex carbon and/or nitrogen source, classified in class 435, subclass 256.8, for example.

2. The inventions are distinct from each other because of the following reasons:

Inventions I-IV are unrelated as different methods. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the inventive groups above are directed to different inventions which are not connected in design, operation, and/or effect. These claimed methods (i.e. Inventions I-IV) are distinguishable, each from the other, because they are four different methods. These four different methods utilize different steps and/or approaches to achieve its preamble objective. For example, the methods of Inventions I-IV are all drawn to a process for the production of Beta-Lactam. However, these methods are distinguishable because Invention I fermentation medium contains only chemically defined components and a beta-lactam producing microbial strain. Invention II fermentation medium contains only chemically defined components and a beta-lactam producing mutated or recombinant microbial strain. Invention III fermentation medium contains chemically defined components and a complex carbon and/or nitrogen source and a beta-lactam producing mutated or recombinant microbial strain. Invention IV fermentation medium contains chemically defined

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components and a complex carbon and/or nitrogen source and a beta-lactam producing microbial strain. Therefore, these four methods are distinct since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. In addition, one would not have to practice the various methods at the same time to practice just one method alone.

3. The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all the above inventions in one application.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirements be traversed (37 CFR 1.143).

Any inquiry concerning this communication should be directed to Randall Winston at telephone number (703) 305-0404. The examiner can normally be reached during the hours of 08:30 to 17:00 Eastern.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Winston whose telephone number is (703) 305-0404. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Brenda Brumback whose telephone number is (703) 306-3220.

Randall O. Winston  
Examiner, 1654



CHRISTOPHER R. TATE  
PRIMARY EXAMINER